



Paper No. 11

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OFFICE OF PETITIONS

In re Application of  
William C.Y. Lee et al.  
Application No. 09/625,626  
Filed: July 26, 2000  
Attorney Docket No. 139.136USU1

DECISION ON  
PETITION

This is a decision on the petition under 37 CFR §1.47(a), filed February 27, 2003

The petition is **DISMISSED**.

The above-identified application was filed on July 26, 2000. At the time of filing, applicant submitted a 37 CFR 1.63 declaration signed by all of the inventors. A non-final Office action was mailed on September 27, 2002. This office action set a shortened statutory period for reply of three months.


In response, on February 27, 2003, with a request for a two month extension of time, applicant submitted a reply and a declaration under 37 CFR 1.131. The 37 CFR 1.131 declaration stated that all of the inventors were responsible for reduction to practice of the subject matter of the rejected claims prior to the date of the reference on which the September 27, 2002 rejection was based. However, the 37 CFR 1.131 declaration was only signed by joint inventor David J.Y. Lee. Applicant has filed the instant petition to have the 37 CFR 1.131 declaration entered despite the fact that the declaration was not signed by joint inventor William C.Y. Lee. According to applicant, William C.Y. Lee has refused to return an executed 37 CFR 1.131 declaration.

However, 37 CFR 1.47 (and a petition thereunder) is only applicable to the initial filing, and PTO acceptance, of an application wherein one or more of the named inventors refuses to sign, or cannot be located so as to sign, the oath or declaration filed under 37 CFR 1.63. Where, as here, all the named inventors have executed the original oath or declaration under 37 CFR 1.63, 37 CFR 1.47 has no relevance to the application. See MPEP 201.03(b); 409.03.

Rather, MPEP 715.04 applies to the situation in hand and notes in pertinent part that (1) an affidavit or declaration filed under 37 CFR 1.131 may be signed by less than all the named inventors when the signing inventors are in fact the inventors of the subject matter of the claim(s) under rejection, or (2) if it is shown that a joint inventor of the claimed invention refuses to sign, the signature(s) of the remaining inventor(s) is sufficient, provided that the declaration under 37 CFR 1.131 shows completion of the invention by all the joint inventors of the claimed subject matter, or (3) the assignee of the entire interest may make the declaration under 37 CFR 1.131.

Accordingly, the file is being returned to Technology Center 2683 for treatment of the petition under 37 CFR 1.47 as part of a showing under the practice of MPEP 715.04.

Telephone inquiries concerning this decision should be directed to the undersigned Petitions Attorney at (703) 305-4497.

  
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